

**REMARKS**

Claims 1 and 5-14 are pending in this application.

Applicants gratefully acknowledge the Examiner's indication of allowability of claims 11-14.

Claims 1 and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated over Clark (U.S. Pat. No. 6,280,396). Applicants respectfully traverse the rejection.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the apparatus disclosed by Clark that would preclude the factual determination that Clark identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claim 1 describes a bioelectrical impedance measuring apparatus. The apparatus comprises a housing and a plurality of rod-like electrode members, each having a plurality of electrodes, are disposed in an upper part of the housing. The upper part of the housing comprises two side edges, and the plurality of rod-like electrode members have a shape

and a length such that an error derived from a change in a posture caused by a difference in a height can be minimized. The rod-like electrodes are arranged and fixed lengthwise along both side edges of the upper part of the housing. The apparatus also comprise a display device having the capability of an operator panel and lying between the electrode members and a weighing device included in a lower part of the housing. The housing accommodates a current supplying device for supplying current to the electrodes, a voltage measuring device for measuring voltage at the electrodes; and an arithmetic means for calculating a bioelectrical impedance value from the supplied current value and the measured voltage values. It is noted that independent claim 8 include the limitations of claim 1 as well as a modem and a display device for displaying information which is acquired over an internet accessed through the modem.

It is contended in the Office Action, at page 5, that the electrode member of Clark's apparatus performs the recited function of minimizing error caused by a change in posture related to a height difference. The Office Action alleges that, for example, a difference in height can be considered to be as little as  $\frac{1}{4}$  inch. Applicants disagree, and submit that this example is not valid, because error caused by a change in posture does not even occur in this example. The height difference cited is so small, that no appreciable error would occur. If no error occurs, the recited error minimizing functionality of the electrode members of the present invention does not come into play.

The problem addressed by the claimed invention is that of minimizing *error that occurs as a result of a change in posture* related to differences in height between people using the apparatus; for example, the difference in height between a child and an adult. Blood flow in the arms depends on a height difference between the heart and both hands. In practicing a bioelectrical impedance method for measuring impedance between both hands, a difference in

blood flow rate influences measured impedance. In particular, blood flow rate is reduced and impedance and percent fat become higher when the hands are higher than the heart, resulting in measurement inaccuracy.

The Examiner points out that a functional limitation in a claim does not distinguish the claimed invention from a prior art reference when the reference discloses the claimed structure, and/or when the structure of the prior art reference can inherently perform the recited function. However, in the present case, Clark's disclosed structure cannot perform the recited function of minimizing error caused by a change in posture related to a height difference.

Clark discloses that the length of its rod-like electrode member is a hand width, as is apparent from Fig. 1, Fig. 2 and Fig. 5. Therefore, it is clear that any posture change that would cause error could not possibly be minimized by the disclosed structure of Clark's apparatus. For example, both a child and an adult cannot grasp Clark's electrode member with the same posture. Thus, measurement error occurs from the change in posture caused by a difference in height in Clark's apparatus.

In contrast, the electrode members of the present invention have a shape and a length such that an error derived from a change in a posture caused by a difference in a height can be minimized, as illustrated in Fig. 1. Therefore, both a child and an adult can maintain the same posture when grasping the electrode members if he/she stretches his/her hands in horizontal direction. A further description is provided at page 7, line 22 to 24 of the specification. Accordingly, there are significant differences between the claimed invention and the apparatus disclosed by Clark that would preclude the Office Action's contention that Clark identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. The Examiner is,

therefore, requested to reconsider and withdraw the rejection of claims 1 and 8 under of 35 U.S.C. § 102.

Dependent claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark in view of Mault (U.S. Pat. No. 6,478,736). Applicants respectfully traverse the rejection for the reason set forth below.

Dependent claims 6, 7 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark in view of Mault and further in view of Kolawa et al. (U.S. Pat. No. 6,370,513). Applicants respectfully traverse the rejection for the reason set forth below.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

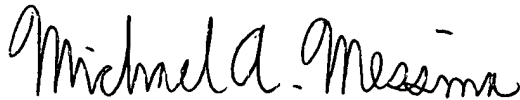
Applicants submit that there is no teaching, suggestion, or motivation to modify the apparatus of Clark to produce the claimed invention. The secondary references (Mault and Kolawa), either alone or in combination fail to remedy the above described deficiencies of Clark. Thus, even if the applied references are combined as suggested by the Examiner, and an Applicants do not agree that a requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, the rejections under 35 U.S.C. § 103(a) are not legally viable and should be withdrawn.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink that reads "Michael A. Messina". The signature is written in a cursive, flowing style.

Michael A. Messina  
Registration No. 33,424

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 MAM:lg  
Facsimile: (202) 756-8087  
**Date: December 7, 2004**